



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/781,775	02/20/2004	Chad G. Harris	12013/51001	3745
23838	7590	12/27/2007		
KENYON & KENYON LLP 1500 K STREET N.W. SUITE 700 WASHINGTON, DC 20005			EXAMINER VU, QUYNH-NHU HOANG	
			ART UNIT 3763	PAPER NUMBER
			MAIL DATE 12/27/2007	DELIVERY MODE PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/781,775

Applicant(s)

HARRIS ET AL.

Examiner

Quynh-Nhu H. Vu

Art Unit

3763

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 30 November 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-11, 13, 14, 16-18 and 20 is/are pending in the application.
- 4a) Of the above claim(s) 5-11, 18 and 20 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-4, 13, 14, 16 and 17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 01 July 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 5/12/04 & 11/29/05.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- ☐ Notice of Informal Patent Application
- ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Election/Restrictions*

Claims 5-11, 18, 29 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected Species II and sub-species B-H, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 11/30/07.

Applicant's election without traverse of Species I, and sub-species A (claims 1-4, 13-14, 16-17 in the reply filed on 11/30/07 is acknowledged.

Claims 12, 15 and 19 are cancelled.

### *Specification*

Claim 16 is objected to because of the following informalities: Nowhere in the specification discloses that "the first elongated shaft comprises a non-absorbing material". Appropriate correction is required.

### *Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-4, 13, 16 are rejected under 35 U.S.C. 102(e) as being anticipated by Ponzi (US 6,540,725).

Ponzi discloses an injection catheter comprising: a first elongated shaft 68 made of a low friction material (Teflon, also it is well known in the art to use low friction material to easy insert

the catheter into the body, it is noted that Teflon is non-absorb material) or 80 having a distal end and a proximal end and a first lumen extending therebetween; a needle 46 with a proximal end and a distal end and a needle lumen extending therebetween, the needle disposed within the first lumen of the the first elongate shaft and extending from a proximal end of the catheter to a distal end of the catheter; and a needle depth control device 17; wherein the needle depth control device comprises a stop collar 106 or 102; a first set of threads 104; a second set of thread 108; the first set of threads is engaged with the second set of threads; a means 110 or 102 for preventing rotation of the stop collar; wherein the stop collar comprises: a plurality of outwardly extending longitudinal protrusion 86 or 104 located on the stop collar; and a plurality of grooves 85 in an inner surface of the elongated shaft 80, (or space between the element 100 and 102).

Claims 1-4, 13, 16-17 rejected under 35 U.S.C. 102(e) as being anticipated by Mickley (US 6,613,017) or Crank et al. (US 6,616,626).

Mickley discloses an injection catheter including all claimed invention. See Figs. 3, 6-8.

Crank discloses an injection catheter including all claimed invention. See Figs. 1-3, 10-12B.

The applied reference has a common injection catheter with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been

obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ponzi.

Regarding claim 16, Ponzi discloses the claimed invention except for the shaft made of polytetrafluoroethylene. It would have been obvious to one having ordinary skill in the art at the time the invention was made to an elongated shaft made of polytetrafluoroethylene, since it has been held to be within the general skill of a worker in the art to select a known material on the basis of its suitability for the intended use as a matter of obvious design choice.

Regarding claim 17, Ponzi discloses the claimed invention. Furthermore, Ponzi discloses that the tube 20 or 22 having a braided mesh to improve torsional stability and eliminate kink when it bent (col. 4, line 55, col. 5, line 10). Ponzi does not disclose that elongated shaft 68 or 80 with a braid. However, . It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a braid on the elongated shaft to improve torsional stability and prevent of kinking.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Quynh-Nhu H. Vu whose telephone number is 571-272-3228. The examiner can normally be reached on 6:00 am to 3:00 pm.

The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Quynh-Nhu H. Vu  
Examiner  
Art Unit 3763

  
